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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,802	10/09/2001	George H. Small	104410-100	6750
28765	7590	01/18/2007	EXAMINER	
WINSTON & STRAWN LLP			PHILOGENE, PEDRO	
PATENT DEPARTMENT			ART UNIT	PAPER NUMBER
1700 K STREET, N.W.			3733	
WASHINGTON, DC 20006				
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
2 MONTHS		01/18/2007	PAPER	

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/972,802  
Filing Date: October 09, 2001  
Appellant(s): SMALL, GEORGE H.

**MAILED**  
**JAN 18 2007**  
**Group 3700**

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Jeffrey A. Wolfson  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/10/06 appealing from the Office action  
mailed 3/1/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

The declaration of George H. Small, M.D., M.P.H. ("Small Declaration")

Signed on February 10, 2005; Filed on February 11, 2005

By George H. Small, M.D., M.P.H.

5938666	Reynolds et al.	8-1999
5006830	Merrit	4-1991
6132447	Dorsey	10-2000

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29,31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 29, line 8, the term "the depth" lacks prior antecedent basis.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29, 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Reynolds et al. (5,938,666).

With respect to claim 29, Reynolds et al disclose an umbilical cod clamp (10) comprising a pair of arms (11,12,31,32) each having a length in a generally V-shaped configuration having rear end portions joined together at an apex thereof and having free forward end portions normally disposed in spaced apart relation; as best seen in FIG.1, and being movable towards each other for clamping an umbilical cord between the arms; a channel (21,22) that extends substantially along the length of at least one arm and is open at the free end portion thereof to facilitate the escape of fluid therefrom when the clamp is closed; as set forth in column 4, lines 32-58; and wherein the depth of the channel increases toward each open end; as best seen in Fig.1, (where the incline of the channel 22 increases the depth toward the open end), and a locking portion (15,16,35,36) for securing the arms together when the clamp is closed; as best seen in Fig.2.

With respect to claims 31-32, Reynolds discloses all the limitations, as best seen in FIG.1. The channel has a width that is 1/3 of the width of each arm, the channel is present in each arm (21,22) and is open at the free end.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt (5,006,830) in view of Dorsey (6,132,447).

With respect to claims 17-25, it is noted that Merritt teaches all the limitations, except for an identification means comprising a gender-identifying color associated with portion of the clamp to facilitate identification of the gender of the baby; as claimed by applicant. However, in a similar art, Dorsey evidences the use of a device to provide umbilical devices with gender-identifying color coding (blue for boys and pink for girls) for readily recognizable indicia associated with newborn baby. Inasmuch as one of ordinary skill in the art would recognize that this newborn baby indicia would also be advantageous subsequent to umbilical cord severing, it would have been obvious to similarly form the Merritt clamp with such color-coding. Whether the entire clamp is formed of blue or pink or a portion remains a neutral color is clearly a matter of personal preference with no criticality having been advanced for either choice.

***Allowable Subject Matter***

Claim 33 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**(10) Response to Argument**

The Affidavit under 37 CFR 1.132 filed 2/11/05 is insufficient to overcome the rejection of claims 17-25 based upon Merrit/Dorsey as set forth in the last Office action because: In paragraph 11 of the affidavit filed 2/11/05 applicant shows no evidence of Long-Felt Need. It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art

were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Applicant's arguments that the webs (21,22) are parallel to and preferably coplanar to the root plane of opposite serrated surfaces, thus Reynolds clearly fails to disclose a remotely suggest an umbilical cord clamp structure where the channel depth increased toward each open end. The examiner begs to differ, because Reynolds also stated that the webs could also be as close as possible to co-planar, but not necessarily so. And as can best be seen in FIG. 1, the web 22 forming the channel is slanted, therefore the depth increases toward the open end.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Merritt teaches of an umbilical clamp with a color coded identification mark and Dorsey teaches of an umbilical scissor with color coded to identify the gender of the infant. Therefore, given

the teaching Dorsey, it would have been obvious to modify the clamp of Merritt, as taught by Dorsey to arrive at the clamp as claimed by applicant. Furthermore, applicant stated that the clamp remains on the baby's cord stump, applicant's attention is directed to Merritt column 3, lines 54-63 where Merritt discloses that the clamp remains attached to the baby's cord stump.

Furthermore, Merritt discloses a color code for identifying the baby with a person responsible for removing the baby from the facility, which color code stays with the baby for a period of time. Thus, a color-coded identification is established. Dorsey discloses a device with a plurality of indicia comprising a plurality of birth-related data, such as a baby's gender (blue for boy and pink for girl), the baby color-coding identification is established. Therefore, combining the teaching of Dorsey with the teaching of Merritt to arrive at applicant device would have been obvious to one of ordinary skill in the art at the time of the invention.

In addition, there is no functional relationship present between the color or indicia and the apparatus or clamp "the color or indicia in no way depends on the apparatus or clamp, and the apparatus or clamp does not depend on the color or indicia". Where the color or indicia is not functionally related to the apparatus or clamp, the color or indicia will not distinguish the invention from the prior art in terms of patentability. Therefore, where ever the claimed apparatus differs from the prior art solely in terms of color or indicia, and there is no functional relationship between the color or indicia and the apparatus or clamp, then the claims are rejected under 35 USC 102 or 103 as anticipated by, or obvious in view of, the prior art reference(s). See *In re Ngai*, 70

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Pedro Philogene



Conferees:

Robert Eduardo

  
Tom Hughes 